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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,951	12/19/2001	Xiaoxiao Zhang	CL/V-31599A	6417

1095 7590 03/27/2003

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EXAMINER

LAVARIAS, ARNEL C

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/025,951

Applicant(s)

ZHANG ET AL.

Examiner

Arnel C. Lavarias

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W

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-25, drawn to an optical lens comprising at least one holographic optical element, classified in Class 359, subclass 15.
 - II. Claims 26-47, drawn to a method for producing an optical lens or composite optical lens comprising at least one holographic optical element, classified in Class 430, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the products as claimed can be made by a materially different process, such as by scribing, embossing, stamping, or by computer generated means.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. **Applicant is required to elect one of the following inventions if election is made to**

Invention I:

Invention IA: Claims 1-7, drawn to an optical lens comprising at least one holographic optical element and at least one focusing element, classified in Class 359, subclass 19.

Invention IB: Claims 8-25, drawn to an optical lens comprising a first holographic optical element and a second holographic optical element, classified in Class 359, subclass 15.

The inventions are distinct, each from the other because of the following reasons:

Inventions IB and IA are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the optical lens comprising a first holographic optical element and a second holographic optical element (i.e. the combination) does not include the particulars of the optical lens comprising at least one holographic optical element and at least one focusing element, the holographic element further characterized as possessing substantially neutral focusing power (i.e. the subcombination). The subcombination has

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separate utility such as optical pickups, optical spectroscopic instrumentation, and liquid display panel applications.

7. **Applicant is required to elect one of the following inventions if election is made to**
Invention II:

Invention IIA: Claims 26-44, drawn to a method for producing an optical lens comprising switching holographic elements, wherein the first and second light beams have proper phase relationships to record a transmission volume grating structure or a reflection grating structure within the first portion of the first surface of the recordable holographic element and the third and fourth light beams have proper phase relationships to record a second transmission volume grating structure within the second portion of the first surface of the recordable holographic element, classified in Class 430, subclass 1.

Invention IIB: Claims 45-47, drawn to a method for producing a composite optical lens comprising at least one holographic lens, comprising the steps of providing a first polymerizable or crosslinkable fluid optical material in a mold, recording a grating structure, providing a second mold, providing a second polymerizable or crosslinkable fluid optical material, and polymerizing or crosslinking the second polymerizable or crosslinkable fluid optical material in the second mold, classified in Class 264, subclass 1.32.

The inventions are distinct, each from the other because of the following reasons:

Inventions IIA and IIB are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are

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shown to be separately usable. In the instant case, all of the subcombinations have separate utility in a combination without the particulars of the other subcombinations.

See MPEP § 806.05(d).

8. **Applicant is required to elect one of the following species if election is made to Invention IIA:**

Species IIA1: drawn to a method for producing an optical lens comprising switching holographic elements, wherein the first and second light beams have proper phase relationships to record a transmission volume grating structure within the first portion of the first surface of the recordable holographic element and the third and fourth light beams have proper phase relationships to record a second transmission volume grating structure within the second portion of the first surface of the recordable holographic element. Claims 33-39.

Species IIA2: drawn to a method of producing an optical lens comprising switching holographic elements, wherein the first and second light beams have proper phase relationships to record a reflection grating structure within the first portion of the recordable holographic element and the third and fourth light beams have proper phase relationships to record a second reflection grating structure within the second portion of the recordable holographic element. Claims 40-44.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is

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finally held to be allowable. Currently, Claims 26-32 are generic to Species IIA1 and IIA2.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. A telephone call was made to Robert J. Gorman (678-415-4389) on 3/21/03 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

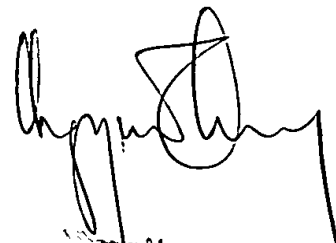
10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 703-305-4007. The examiner can normally be reached on M-F 8:30 AM - 5 PM.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.


Arnel C. Lavarias
March 24, 2003


Arnel C. Lavarias
March 24, 2003